86-425

Supreme Court, U.S.
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NO.

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1986

JOSEPH O. OBIAYA, PETITIONER
v. BABCOCK & WILCOX CO., ET AL.

PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

Joseph O. Obiaya
Petitioner
4773 Walford Road #13
Warrensville Heights, OH 44128

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4773 Walford Road #13
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## QUESTIONS PRESENTED FOR REVIEW

1. Is the Court of Appeals' interpretation of a skilled artisan under 35 USC §103 as a nonentity valid?

2. Did the Court of Appeals overreach the provisions mandated by the Supreme Court decision of Graham v. Deere?

3. Can the Court of Appeals' determination of nonpatentability that is based upon the teaching of prior art references be sustained, under 35 USC §103, even though a team of skilled artisans, who were faimilar with the teachings of the same references, failed in prior efforts to develop the invention?

4. Does failure by others as described in 3 above deserve "primary"

or "secondary" consideration in the determination of nonobviousness?

5. Is the Obiaya '458 patent obvious or nonobvious?

## PARTIES TO THE PROCEEDINGS

1. Commissioner of the Patent and Trademark Office

2. Babcock & Wilcox Parent Company, Requester of patent reexamination.

a) Bailey Controls Company, a Division of Babcock & Wilcox (formerly Bailey Meter Company, a subsidiary of Babcock & Wilcox).

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## OPINIONS DELIVERED IN THE COURT OF APPEALS AND UNITED STATES PATENT AND TRADEMARK OFFICE

1. Patent and Trademark Office Board of Appeals and Interferences Decision of July 23, 1985, 227 USPQ 59 (1985).

2. United States Court of Appeals for the Federal Circuit decision of May 30, 1986 (Unpublished).

## STATEMENT OF THE GROUNDS ON WHICH THE JURISDICTION OF THIS COURT IS INVOKED

This is a petition for Writ of Certiorari following judgment on the reexamination of U.S. Patent No. 4,128,458 by the United States Court of Appeals for the Federal Circuit (Referred to henceforth as the Court of Appeals) on May 30, 1986. Jurisdiction

is conferred on this Court by 28 USC 1254 §1

The Court of Appeals decided an important question of federal law which has not been, but should be, settled by this Court. In the process, it failed to adhere to the Supreme Court mandate for determining patentability; it interpreted the law in conflict with other decisions by the same court and by other federal courts. Thus, the jurisdiction of this Court is invoked.

## STATUTE INVOLVED 35 USC §103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior act

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

## STATEMENT OF THE CASE

This petition for Writ of Certiorari stems from a United States Court of Appeals for Federal Circuit's Decision affirming the Patent and Trademark Office's, specifically the examiner's and the Board of Appeals and Interferences', determination that the claims of U.S. Patent No. 4,128,458 [App. 1][1] issued December 5, 1978 to Joseph O. Obiaya are not patentable. The patent claims a combined combustibles and oxygen concentration analyzer.

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[1]The Appendix is in a separate volume; submitted evidence before the Court of Appeals. Citations to the Appendix designate the Appendix page by number.

In September, 1982, Mr. Obiaya sued the Babcock & Wilcox Company and codefendent Lubrizol Corporation for infringement of the patent in the U.S. District Court for the Northern District of Ohio (Civil Action No. C-82-1889) under 35 USC §§271 and 281. Jurisdiction was conferred upon that Court by 28 USC §1338(a). On September 26, 1983, pursuant to 35 USC §302-307, defendant Babcock & Wilcox requested reexamination of the patent [App. 17], which was granted. In the process of discovery, just at the time the petitioner, Mr. Obiaya, sought to depose those individuals (employees of Babcock & Wilcox) who failed in an earlier attempt to develop the invention, Babcock & Wilcox obtained a stay in proceedings in the District

Court, over the objections of petitioner, pending the reexamination outcome, by an order dated February 17, 1984 [Petition 44][2]. Babcock & Wilcox argued before Judge Lambros that Mr. Obiaya could rely on affidavits and declarations to prove his case. Judge Lambros thus noted in that order that:

> "Plaintiff will have the opportunity to present his position with respect to this prior art at the reexamination proceedings in the form of affidavits and declarations. 37 C.F.R. §§1.131-32. [Petition 50, 51]

In the reexamination determination the examiner issued a final rejection [App. 314] of all claims on October 19,

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[2]Appendix to this petition is in a separate accompanying volume. Citations designate the appendix number.

1984, relying on a combination of newly cited references. The rejection was affirmed by the Patent Office Board of Appeals and Intereferences on July 23, 1985 [App. 337] and by the Court of Appeals on May 30, 1986. The Court of Appeal's rejection under 35 USC 103 asserts that a combination of references brought to the attention of the Patent Office by the requester/defendant Babcock & Wilcox would suggest the invention to one of ordinary skill. [Petition 2, 3] (Note that the rejection was under 35 USC 103 and not under 101 or 102; the invention, therefore is significantly different from the prior arts and has advantages over them; the issue is limited to the obviousness or nonobviousness of it.)

The inventor/petitioner, Mr. Obiaya, however submitted factual evidence which directly rebuts the obviousness determination. The evidence [App. 188, 307] shows failed attempts by the requester, Babcock & Wilcox, to develop the invention even while armed with knowledge of the same prior arts references relied upon for the rejection of the primary claims. The principal prior art references (the OC, Heat Prover, Ross et al) were developed, marketed and assigned to Babcock & Wilcox. [App. 40, 60, 10]

A Babcock & Wilcox research team of three engineers and two senior technicians undertook the development work. The project was headed by one Thomas L. Bohl, a company senior project engineer [App. 189] and began as early

as 1975 as witnessed by Babcock & Wilcox report 8094 dated August 19, 1975 [App. 20]. The Babcock & Wilcox product which infringed Mr. Obiaya's invention was commercially introduced in 1981. Several designs were fabricated and extensively tested without success before Mr. Obiaya's solutions were adopted. [App. 188, 307] The failed designs lacked an essential component of the invention. Even though Babcock & Wilcox was familiar with this particular component and had used it in other products, they failed to recognized its usefulness in this invention; its use was not obvious to them. If for no other reason the invention should have been allowed on account of the nonobviousness of this component to Babcock & Wilcox. The provision in the

103 statute stipulates that the invention must be considered as a whole. While the Court of Appeals and the Patent and Trademark Office noted the unique advantageous application of this component, they still concluded that it would have been obvious.

The Court of Appeals and the Patent and Trademark Office rejected the evidence of failure by Babcock & Wilcox in their determination of obviousness. They determined obviousness wholly subjectively. Neither the Court of Appeals nor the Patent Office cited any precedent cases in support of their rejection of this evidence. However precedent cases and opinions of the courts exist in support of the use of failure by others in general.

## ARGUMENT

### I. Meaning of Skilled Artisan under 35 USC 103

The examiner's decision on the basis of 35 USC 103 that the Obiaya '458 patent would have been obvious to "a person having ordinary skill in the art" has been rebutted by evidence showing facts that existed at the time the invention was made. The evidence [App. 188, 307] shows that one skilled in the art, Babcock & Wilcox, did in fact attempt to develop the invention without success even though thoroughly knowledgeable concerning the same prior art references relied upon by the examiner. All the prior arts (the OC, Heat Prover and Ross et al patent) [App. 40, 60, 10] cited against the primary claims, Claims 1, 2, 3 14 were

developed, marketed and assigned to the same company, Babcock & Wilcox, that failed in an earlier attempt to develop the invention. The examiner held that the skilled artisan of 35 USC 103 refers exclusively to a phantom person and factual evidence relating to specific activities, persons and results is not relevant:

> Whether the invention is or is not obvious to a specific person [Babcock & Wilcox in this case] is not really germaine. The test is whether or not the invention would be obvious to one of ordinary skill in the art, that "one" not being any specific person or persons [Petition 33, 34]

The Board of Appeals and Inteferences adopted this interpretation [Petition 13] and the Court of Appeals found no error in the Board's rejection [Petition 2]

In the District Court decision of Studiengesellschart Kohle, m.b.h. v. Dart Industries, Inc., 549 Supp. 716, 216 USPQ 381 (D.C. Del., 1982) (Aff'd. 726 F.2d 724) the evidence indicated that a team of DuPont researchers who were familiar with the same prior art that allegedly rendered the invention obvious failed to produce the catalyst of the invention. The court found that:

> The efforts of the exploratory group do not demonstrate that Fischer and Hall and Nash or other prior art render Zibgler's '115 obvious. DuPont chemists read the Fischer patent early. Despite a major effort, involving many experienced scientists with high priority access to the resources of DuPont's experimental station, the DuPont group explored a number of alternatives before investigating Alkyl Aluminimums. If, as Dart argues, ethyl aluminum chlorides are "obviously" the mechanism of the Fischer patent one would expect DuPont

> to have looked into them more immediately." Id. at 735 and 394.

In the present case, not only was the Babcock & Wilcox research team aware of all the principal references (in contrast with the DuPont team which read only the Fischer Patent) but they also actually developed and marketed the prior art devices. Had the Obiaya invention been so obvious, why had not Babcock & Wilcox been led directly to the solution? Babcock & Wilcox had working (not merely theoretical) knowledge of the prior art references.

The examiner's interpretation of the skilled artisan of 35 USC 103 as a phantom person is clearly in error. The Court of Appeals and the Patent and Trademark Office determined obviousness to the skilled artisan wholly

subjectively and contrary to the factual evidence; yet the art of invention, after all, is generated by real people tackling real problems in real world settings.

II. The Scope of the Supreme Court Mandate of Graham v. Deere.

The Court of Appeals implied that it gave discretionary consideration to evidence of failure by Babcock & Wilcox:

> The requesters purported failure to produce the claimed invention is insufficient in this case to rebut the Board's prima facie case of obviousness [Petition 4]

The Court of Appeals implied by the foregoing that it gave "secondary consideration" to the evidence of failure by others in this case as mandated by the Supreme Court decision of Graham v. John Deere, 383 US 1, 86 S.

Ct. at 694, 148 USPQ 459 at 467 [8]. The circumstances of this case, however, require that it be given "primary consideration."

While the Supreme Court gave evidence of failure by others in the Deere decision "secondary consideration" to be used at the discretion of the court for tipping the scale of patentability, it should be emphasized that the court also noted the specific nature of the failure by others. The court made clear that those who failed in the Deere case, supra, had no prior knowledge of the prior art cited against the invention:

> ". . . no one apparently chose to avail themselves of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search." Id. at 703, 474.

Even though the Supreme Court stated in the use of that evidence that it is irrelevant that no one chose to avail themselves of knowledge through patent search, it did not say that it would have been irrelevant had knowledge of the prior art been acquired before the failed attempt. The differences in the nature of failure by others between the Deere case and the present case are, therefore, quite significant: the former offers incomplete answers while the latter provides complete answers for determining nonobviousness or obviousness.

When inquiry is made in both cases as to what a skilled artisan would have done who is armed with the referenced arts at the time of the invention, the answer provided by the Deere case is at

best inconclusive. In the instant case the answer is definite. With respect to the Deere case, the argument can be made that the result of the failed attempt might have been different had the individuals been armed with knowledge of all the prior art. It is safe to surmise therefrom that it is because of this gap in the Deere evidence that the Supreme Court gave it a "secondary consideration."

It is submitted that the preponderance of patent cases are in the Deere class, lacking the necessary evidence for determining obviousness or nonobviousness objectively. The extensive analysis in the Deere case, supra, (Id. at 691-694, 464-467) pertains to this class of cases and is a systematic attempt to standardize the

subjective determination process in a way that approximates objectivity. However the evidence of the failure of Babcock & Wilcox in this particular case permits absolute objectivity in the determination of nonobviousness. One can venture to say, therefore, that the Supreme Court did not consider the circumstances of this type of case because the determination of non-obviousness is self-evident from the 103 statute, and its occurence rare. The Supreme Court recognized the fallibility of human judgments and so cautioned, in the exercise of the discretion granted the courts in the Deere class (of secondary evidence), against the danger of slipping into hindsight and reading into prior art the teachings of the invention in issue.

Given these facts, the evidence of failure by Babcock & Wilcox to develop the invention should have been given "primary" and not "secondary" consideration as it is implied by the comment of the Court of Appeals. This assessment is in agreement with the opinion of the Court of Appeals in W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1984):

> It is difficult but necessary that the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of the one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. Id. at 1553, 313.

This "Litmus test" for patentability interpreted here by the Court of Appeals is directly applicable in the present

case. Babcock & Wilcox in reality is one such skilled artisan who was presented "with the references." Thus failure by Babcock & Wilcox deserves "primary consideration." Inasmuch as human judgments are not infallible it is submitted that actual facts are more cogent than an expert's opinion; yet the Court of Appeals and the Patent and Trademark Office ignored the failure of Babcock & Wilcox as not meeting the test of patentability.

The Supreme Court opined in Graham v. Deere, supra, that:

> The emphasis on nonobviousness is one of inquiry, not quality and as such comports with constitutional strictutures. Deere at 693[13], 467[7].

What better inquiry can there possibly be than the foregoing; it is direct and to the point.

The Court of Appeal's decision rests on the opinion that: "The prior art relied on by the Board is 'reasonably pertinent to the particular problem with which [Obiaya] was involved', In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and was not improperly construed with the claimed invention in mind, In re Antle, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971)," [Petition 2, 3]

The pertinency of the prior arts is not at issue. The point of contention is the inference that was drawn from the cited prior arts and the manner by which that determination was made. The Court concluded that:

> Each element of Obiaya was contained in the prior art reference and their combination would have been

> suggested [to a skilled artisan] by those references [Petition 3].

Yet the Court of Appeals and the Patent and Trademark Office ignored the evidence, the failure of Babcock & Wilcox, which prove otherwise. Neither of the two referenced opinions, In re Wood, supra and In re Antle, supra, address this central issue.

The skill of Babcock & Wilcox research team is not in doubt. Thomas L. Bohl, the project leader, is a named inventor on ten U.S. Patents a copy of the description from the Patent Office Official Gazette for each of these patents is of record [Reply App. 5] to show they relate to the gas analyzer field. Each of these ten patents is assigned to the Babcock & Wilcox Company. Mr. Bohl's work on

these inventions in combination with his acknowledged engineering duties and experience (also of record [App. 293-295] establish Mr. Bohl as one of greater than ordinary skill in the gas analyzer field.

Mr. Edward William Fisher [App. 189], a research specialist and a member of the research group, is a named inventor of U.S. Patent No. 4,063,898 entitled "Combustibles Gases Detector" [App. 110] which was cited against Claim 5 of the Obiaya '458 patent.

Ms. Sharon L. Zimmerlin, an engineer, another member of the group [App. 193], is a named inventor of U.S. Patent No. 4,355,056 entitled "Method of Manufacturing A Combustibles Sensor."

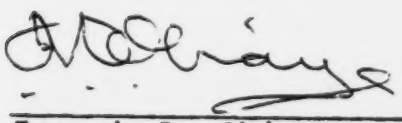
If the Obiaya '458 patent was not obvious to these individuals (members of

the research team), with priority access to Babcock & Wilcox wealth of information and with working knowledge of the referenced prior arts, then the argument is made that it was obvious to the Court of Appeals and the Patent and Trademark Office only from the vantage point of hindsight.

## CONCLUSION

Because of the blatant misappliation of the law by the Court of Appeals, allowance of this petition is solicited.

Respectfully submitted,



Joseph O. Obiaya
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## CERTIFICATE OF SERVICE

This is to certify 3 copies of the foregoing PETITION FOR WRIT OF CERTIORARI has been served by U.S. Air Mail, Postage Prepaid, on the Solicitor General, Department of Justice, Washington, D.C. 20530, and that 3 copies of the foregoing PETITION FOR WRIT OF CERTIORARI has been served by U.S. Air Mail, Postage Prepaid, on Thomas C. Tarolli, Esq., Yount & Tarolli, 1111 Leader Building, Cleveland, Ohio 44114, Attorney for Requester Babcock & Wilcox Company this 15th day of September, 1986.

Joseph O. Obiaya

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE JOSEPH O.OBIAYA )Appeal No. 86-551
)

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DECIDED: May 30, 1986

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Before MARKEY, Chief Judge, NIES and ARCHER, Circuit Judges. MARKEY, Chief Judge.

DECISION

The decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences (board), affirming the examiner's final rejection in a reexamination proceeding of claims 1-5, 7-12, and 14_*/ of U.S.

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_*/ The board rejected claims 6 and 13 for double patenting of the obviousness type. Accordingly, Obiaya has filed a terminal disclaimer. See In re Longi, 759 F.2d 887,894,225 USPQ 645,649 (Fed. Cir. 1985); 37 C.F.R. § 1.321 (1985). The Solicitor has informed the court that

Patent No. 4,128,458, issued December 5, 1978 to Joseph O. Obiaya, as nonpatentable under 35 U.S.C. § 103, is affirmed. 227 USPQ 58 (Bd Pat App & Int 1985).

Obiaya failed to show error in the board's rejection of claims 1-5, 7-12, and 14 under § 103 in view of the prior art.

The examiner established a prima facie case showing that the claimed invention would have been obvious to one of ordinary skill in the art. We do not agree with Obiaya's contention that the examiner dissected the references to recreate a facsimile of the claimed invention. The prior art relied on by the board is "reasonably pertinent to

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those claims are no longer in issue.

the particular problem with which [Obiaya] was involved," In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979), and was not improperly construed with the claimed invention in mind, In re Antle, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971). Each element of Obiaya was contained in the prior art references and their combination would have been suggested by those references.

The board correctly rejected claims 1, 2, and 7 over the disclosures of "Product Specification E65-1, Oxygen and Combustibles Analyzer", 1956 (OC Analyzer), or "Product Instructions E65-15, Heat Prover Combustion Analyzer", 1956 (Heat Prover), in view of U.S. Patent No. 3,960,500 (Ross). The examiner properly concluded that the use

of an aspirator to cause negative pressure to draw the gas sample through the device was well known to those in the art. Ross discloses the use of an aspirator to draw gas past an oxygen sensor. Nothing of record supports Obiaya's contention that the aspirator is solely responsible for an "improved" response time. The use of a pressure regulator for an aspirator would have been obvious in view of Bulletin P-23 of Thermox Instruments, Inc., 1976. The requester's purported failure to produce the claimed invention is insufficient in this case to rebut the board's prima facie case of obviousness.

The board properly rejected claims 3, 4, 8-11, and 14 over OC Analyzer, or Heat Prover in view of Ross and U.S. Patent No. 2,531,592 (Yant), U.S. Patent

No. 1,321,063 (Lamb), or U.S. Patent 2,743,167 (Cherry) under § 103. Nothing of record supports Obiaya's contention that those skilled in the art would not have used a labyrinth heater because it would cause a significant increase in an already "slow" response time. The board correctly determined that Obiaya has merely recognized another possible advantage of using that heater. 227 USPQ at 60.

Lastly, the board properly rejected claims 5 and 12 over OC Analyzer or Heat Prover in view of Ross, Yant, Lamb, or Cherry, and U.S. Patent 4,063,898 (Fisher) for the reasons stated by the examiner.

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Art Unit 112 Paper No. 33

Appeal No. 632-75

HEARD:
May 29, 1985

UNITED STATES PATENT
AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

---

Ex parte Joseph O. Obiaya

- - -

Request filed September 26, 1983, Control No. 90/000,449 for the Reexamination of Patent No. 4,128,458, issued December 5, 1978, based on application Serial No. 845,049, filed October 25, 1977. Combustible Element and Oxygen Concentration Sensor.

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Stephen J. Schultz et al. for appellant.

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Primary Examiner - T. Tung.

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Before Merker, Katz and Pellman, Examiners-in-Chief. Katz, Examiner-in-Chief.

This is a reexamination of Patent No. 4,128,458 and was requested by the defendant in an infringement suit brought by patentee.

This is an appeal from the final rejection of claims 1 through 14, which are all the claims in the case.

Claims 1 and 6 are illustrative of the appealed claims and read as follows:

1. A combustible fluid and oxygen concentration sensor comprising:

a. a combustible concentration analyzer;

b. an oxygen concentration analyzer;

c. conduit means for routing

a fluid sample past said combustible concentration analyzer and oxygen concentration analyzer;

d. an inlet port to said conduit means for receiving a sample fluid;

e. an outlet port from said conduit means for ejecting said sample after analysis;

f. means for producing fluid flow in said conduit means from said inlet port to said outlet port;

g. means to connect the combustible concentration analyzer to an indicator; and

h. means to connect the oxygen analyzer to a second indicator;

i. said conduit means comprising;

i. first and second portions arranged to divide the flow into separate paths downstream from said inlet and upstream from said flow producing means;

ii. said first portion supplying the oxygen analyzer but not the combustible analayzer

[sic, analyzer] with sample fluid;

iii. said second portion supplying the combustible analyzer but not the oxygen analyzer with sample fluid;

iv. a heater associated with said second portion upstream of said combustible analyzer; and

v. an inlet for providing air to said second portion upstream of said heater, to insure complete combustible analysis within said combustible analyzer.

6. The combustible fluid and oxygen concentration analyzer of Claim 4 where said oxygen concentration analyzer comprises:

a. a reactor member;

b. a heater element, configured in the form of a mesh structure, embedded within said reactor member; and

c. a base for mounting said reactor member;

d. said reactor member comprising:

i. an electrolyte with oxygen ion vacancies providing paths for oxygen ion conduction;

ii. a first and second conductive electrode for inducing a voltaic reaction within said source, and

iii. means for connecting said first and second conductive electrodes to external means for measuring the voltage difference created in said electrodes by said voltaic reaction.

The claimed invention relates to a sensor containing a combustion fluid and oxygen concentration analyzer in which a fluid sample is drawn into the sensor apparatus and separated into two parts, one part going to the oxygen analyzer and the other part going to the

combustion analyzer. A heater is employed to maintain the sample going to the combustion analyzer at a constant temperature to obtain uniform results. An inlet is also provided such that air can be used to combust the materials going to the combustion analyzer. The components of the oxygen analyzer are set out in greater detail in claims 6 and 13.

The references relied on are:

| | | |
|---|---|---|
| Lamb et al. | 1,321,063 | Nov. 4, 1919 |
| Yant et al. | 2,531,592 | Nov. 28, 1950 |
| Cherry | 2,743,167 | Apr. 24, 1956 |
| Ross et al. | 3,960,500 | June 1, 1976 |
| Fisher | 4,063,898 | Dec. 20, 1977 |
| Obiaya | 4,129,491 | Dec. 12, 1978 |

"Product Specification E65-1, Oxygen and Combustibles Analyzer," 1956

"Bailey Product Instructions E65-6, Gas Analyzers Type OA, OB and OC", 1965

"Product Instructions E65-15, Heat Prover Combustion Analyzer", 1956

Bulletin P-23 of Thermox Instruments,

Inc., 1976

Claims 1, 2, and 7 stand rejected under 35 U.S.C. 103 in view of the combination of OC Analyzer, Heat Prover or E65-1 in view of Ross et al. Claims 3, 4, and 8 through 11 and 14 stand rejected for the same reasons and further in view of Yant et al., Lamb et al. or Cherry. Claim 7 stands rejected for the same reasons and further in view of Thermox. Claims 8 and 11 stand rejected under 35 U.S.C. 103 in view of the combination of OC Analyzer, Heat Prover or E65-1 taken with Ross et al., Thermox and Yant et al., Lamb et al. or Cherry. Claims 5 and 12 stand rejected under 35 U.S.C. 103 over OC Analyzer, Heat Prover or E65-1 taken with Ross et al. and either Yant et al., Lamb et al.

or Cherry and further in view of Fisher. Claims 6 and 13 stand rejected under the judicially-created doctrine of obvious type double patenting in view of the combination of the patented subject matter of claims 1 through 3, 6 and 7 of Obiaya taken with OC Analyzer, Heat Prover or E65-1 with Ross et al. and also either Yant et al., Lamb et al. or Cherry.

We have carefully considered the arguments in this case and find that we agree with the examiner for the reasons set forth in the Answer. We adopt these reasons as our own and add the following only for purpose of emphasis.

In view of the fact that the examiner has answered each of the points made by appellant, it would be

redundant to repeat these points. We will restrict our comments to the highlights of the appeal.

The main features of the claimed invention relate to the parallel flow of a divided sample to two different analyzers, a vacuum to draw the sample to the analyzers and then to exhaust, and a heater means upstream of a combustion analyzer. A number of the claims call for specific features, such as a labyrinth heater, a pressure regulator and the use of a specific combustion sensor.

We believe that the references clearly disclose each of the features in similar apparatus such that one skilled in this art having these references available would have found the claimed invention to be obvious. The examiner

has established a prima facie case of obviousness. See In re Lintner, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and In re Greenfield, 571 F.2d 1185, 197 USPQ 227 (CCPA 1978). A number of the references, exemplified by E65-1, disclose that it is well-known to divide a sample into separate parts and pass one part to an oxygen sensor and the other part to a combustion sensor, the parts then being recombined and exhausted. Ross et al. disclose that the art recognizes that samples may be aspirated or sucked into the system so as to pass through the sensor. A number of the references disclose labyrinth heaters, pressure regulators and, as set forth in the claims of the Obiaya patent, combustion analyzers of the type described in claims 6 and 13, now before

us.

Appellant has pointed out the deficiencies in each of the references. However, the rejection is based on the combination of references. The test of obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references, but what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. Note In re Rosselet, 347 F.2d 847, 146 USPQ 183 (CCPA 1965) and In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972). We believe that one skilled in this art would have understood that the various features of the references could be combined to obtain the expected additive results.

Appellant has presented evidence to indicate that a shorter response time is obtained when a labyrinth heater is employed, this being an unexpected result. However, the references disclosing labyrinth heaters indicate that the advantage obtained by using such heaters is that samples are maintained at a uniform temperature. The fact that appellant has recognized another advantage which wold flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Note In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

The examiner has rejected

claims 6 and 13 on the judicially-created doctrine of double patenting of the obviousness type. The determination of whether the rejection is proper under the reexamination statute is a question of first impression. The Statute governing reexamination of patents is contained in 35 U.S.C. 301-307.

35 U.S.C. 301 contains the key language that:

> "Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications." (emphasis added).

Section 302 states that a request for reexamination by the Office of any claim of a patent may be:

> "on the basis of any prior art cited under the provisions of Section 301." (emphasis added).

However, Section 303(a) states that the Commissioner, on his own

initiative, may initiate a reexamination procedure[1]. He may determine whether a substantial new question of patentability has been raised by the request with or without consideration of other patents or printed publications, as well as those cited pursuant to Section 301. We note that the words "prior art," used in Sections 301 and 302, do not appear in this Section.

The Statute refers to both patents and printed publications. Patents are printed as publications by most countries[2], and if they are to be used only in such capacity then there

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[1] Houston Atlas Inc. v. Del Mar Scientific Inc., 217 USPQ 1032 (at 1037).

[2] Manual of Patent Examining Procedure, 4th Ed., Aug. 1983, page 900-5, Section 901.05D(b), Unprinted Foreign Patents.

would have been no reason for this redundancy. We must assume that Congress intended patents to also be the basis for rejection other than as a printed publication. Thus, patents may be used as evidence of prior inventorship by another or as evidence that the patentee of the reexamination patent has already obtained patent protection for his invention. The second patent would be barred by Section 101 if the inventions are identical or by the judically-created doctrine of double patenting of the obviousness type, if there are only obvious differences between the claims of the respective patents.

However, Section 301 contains the limitation "prior art" to describe the patents and printed publications.

Normally, "prior art" rejections exclude those based on public use or sale and those based on Section 112.[3]

Where do "double patenting rejections of the obviousness type" fit in? Are they permissible under the reexamination statute, or are they, like public use and sale rejections, and Section 112 rejections (except as to new and amended claims), excluded? In re Etter, supra, states (p. 4):

> "Patent claims are reexamined only in light of patents and printed publications under 35 U.S.C. ¶¶ 102, 103..."

Double patenting rejections are analogous to Section 103 rejections and

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[3] In re Etter, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (at 4) states that "...only new or amended claims are also examined under 35 U.S.C. ¶¶ 112 and 132, 37 CFR 1.552; MPEP ¶ 2258.

depend on the presence of a prior "patent" as the basis for the rejection. Thus, we take the position that such rejection falls within the ambit of those intended by the statute and are not specifically excluded by the Etter case. Further, the Etter court focused on the question of presumption of validity with regard to a reexamination patent and its statement as to the scope of proper rejections in the evaluation of a reexamination patent are not the point of the ruling.

We now deal with the merits of the double patenting rejection. The rejection is based on the evidence that the general combination of oxygen and combustion analyzers used with sampling devices is known and that it would have been obvious to employ the particular

oxygen analyzer defined in the claims of the Obiaya patent in combination with the sampling device. We believe that claims to such combination do not define a separate and distinct invention from the claims to the oxygen analyzer.

Appellant has indicated that it would be futile to add a terminal disclaimer to this reexamination application since this application has a patent date which is earlier than that of the other Obiaya patent. It appears that appellant's choice is clear. He may acquiesce in the double patenting rejection or he may file a terminal disclaimer in his other patent, assuming that the Obiaya patent and the present application are commonly owned.

The decision of the examiner is affirmed.

AFFIRMED

| | | |
|---|---|---|
| Evelyn K. Merker<br>Examiner-in-Chief | ) | |
| | ) | BOARD<br>OF |
| Murray Katz<br>Examiner-in-Chief | ) | PATENT APPEALS<br>AND |
| | ) | INTERFERENCES |
| Irving R. Pellman<br>Examiner-in-Chief | ) | |

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U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

90/000,449 09/26/83
Joseph O. Obiaya

Before the Board of Appeals

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Stephen J. Schultz
for Appellant

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Examiner's Answer

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This is an appeal from the final rejection of claims 1-14. No claims is allowable. The invention is adequately described on pages 1-4 of the Brief.

This is a re-examination requested by Babcock & Wilcox, the defendant in an infringement suit brought by patentee Obiaya. Eleven claims were originally allowed in the patent. During re-examination, claims 5, 6 9-11 were amended, and claims 12-14

were added.

References of Record Relied on Are:

| | | |
|---|---|---|
| 3,960,500 | Ross et al | June., 1976 |
| 4,063,898 | Fisher et al | Dec., 1977 (filed Sept., 1976) |
| 1,321,063 | Lamb et al | Nov., 1919 |
| 2,531,592 | Yant et al | Nov., 1950 |
| 2,743,167 | Cherry | April, 1956 |
| 4,129,491 | Obiaya | Dec., 1978 |

"Product Specification E65-1, Oxygen and Combustibles Analyzer", 1956

"Bailey Product Instructions E65-6, Gas Analyzers Type OA, OB and OC, 1965"

"Product Instructions, E65-15 Heat Prover Combustion Analyzer" 1956

Bulletin P-23 of Thermox Instruments, Inc., 1976

Claims 1, 2 and 7 stand rejected over OC Analyzer, Heat Prover or E65-1 as obvious in view of Ross et

al under 35 USC 103.

In the prosecution of the original application, a Pebler et al reference (U.S. Pat. No. 3,791,936) was cited as showing a combination of an oxygen sensor and a combustible sensor. However, the reference fails to show the two sensors disposed in parallel flow paths. This was argued by the then applicant as a key distinction, and the case was subsequently allowed. Among the prior art submitted by the requestor are OC Analyzer, Heat Prover and E65-1 (fig. 5), each of which shows an oxygen sensor an a combustible sensor disposed in parallel flow paths.

Claim 1 now calls for drawing (negative pressure) a sample through a device by suction from a means such as an aspirator downstream thereof in

contrast to pushing (positive pressure) the sample through by a means such as a pump upstream thereof. The primary references OC Analyzer, Heat Prover and E65-1 are of the latter type. It is now patentee's position that this difference of flowing a sample through the device by drawing instead of pushing is a key distinction over the primary references.

The use of negative pressure to flow a sample is well-known in the art. Ross et al discloses air aspirator 62 downstream of oxygen sensor 98 to draw a sample past the sensor. The Ross et al sensor is a solid electrolyte oxygen sensor used in high temperature environments such as combustion flue gases, the same as patentee's oxygen sensor. It would certainly be prima facie obvious to one of ordinary skill

in the art to substitute such a flow-drawing means in place of the flow-pumping means of the primary references.

Patentee argues that the use of negative pressure means to produce sample flow obtains unexpected result in that there is a significant reduction of response time. He points to Heat Prover E65-5, page 2, (a copy submitted with the Sept. 4, 1984 response) as showing 15 seconds response time, and E65-1, page 2 (a copy submitted with the Sept. 4, 1984 response), as showing 10 seconds response time. These sensors represent the sesors of the primary references, using positive pressure to flow the sample. Patentee then points to E65-30-1 disclosing the "OJ" type sensor (a copy submitted with the Sept. 4, 1984 response), which uses air

aspirators to draw (negative pressure) a sample through the device. This "OJ" sensor of Babcock and Wilcox is alleged by patentee to correspond to patentee's sensor. The apparent publication date of 1981 is subsequent to patentee's filing date of 1977 and thus is unavailable as a reference. The E65-30-1 brochure shows on page 6 a response time of less than 2 seconds. Thus, patentee contends that the response time is reduced by at least 5 fold.

The examiner does not consider this to be an adequate showing of unexpected result. In order to rely upon the flow-drawing means as the patentable distinction, patentee must demonstrate that that means is responsible for the unexpected result of the reduced response time. To do so, it

must be shown that all parameters other than the flow-producing means was kept constant when tests were run. However, in the instant situation, the data is taken from listings in advertising brochures. There are no conditions given for the test runs, and there is no indication that all parameters other than flow-producing means were constant. How can the data be a valid indication of the effect of the flow-producing means? It is like comparing apples with oranges.

Patentee argues that it is unfair for the examiner to rely upon the brochures cited by requestor Babcock & Wilcox as prior art but to refuse to accept the validity of certain data set forth therein. He characterizes it as being illogical and inconsistent.

The examiner totally disagrees with this characterization. There is no refusal to accept the data as being valid and accurate. However, without further information as to how the data was obtained, the bare data, assuming that it is valid and accurate, simply will not substantiate patentee's contention that the negative pressure flow means brought about the unexpected result of reduced response time.

Patentee further argues that the history of the invention proves its unobviousness. Through affidavits by the patentee and a partial copy of a deposition of one Thomas L. Bohl, who was patentee's supervisor at the time when he was employed by Babcock & Wilcox patentee is attempting to show that the actions by Bohl during patentee's

employment there tend to indicate the invention to be unobvious. The gist of the argument is that Bohl was unable to arrive at patentee's solution when problems arose during the designing stages of the device. And if the invention was so obvious why did not Babcock & Wilcox first manufacture combination sensors which used negative pressure flow means?

First, even though the evidence given by the patentee is under oath and presumed to be completely factual as he sees it to be, Bohl has had no chance to rebut the representations set forth in the affidavits to give us a complete picture of the circumstances.

Second, whether the invention is or is not obvious to a specific

person (Bohl in this case) is not really germaine. The test is whether or not the invention would be obvious to one of ordinary skill in the art, that "one" not being any specific person or persons.

As to why Babcock did not first manufacture the "OJ" sensors (combination sensors with negative pressure flow means), assuming that is the case, the question can have many answers including economic viability and market conditions. Any answer would be speculative and should have no effect on the issue of obviousness at hand.

Two other points need to be discussed so far as claims 1, 2 and 7 are concerned.

First, do the references discloses a "heater...upstream of said

combustible analyzer"? The gas flow path of each primary reference runs through a constant temperature block prior to passing into the combustible analyzer. This block is heated and clearly provides a heater for the gas flow path prior to entering the combustible analyzer. Note heater 26 in OC Analyzer for heating the block.

Second, the pressure regulator of claim 7 is used in the air aspirator to maintain constant pressure in the compressed air conduit and thus insure uniform aspirator function. It is totally obvious that aspirator function would be influenced by the compressed air pressure. Thus, a pressure regulator, of itself a well-known device, is obviously desirable in the aspirator by Ross et al.

Claims 3, 4, 8 and new claims 9-11, 14 stand rejected over OC Analyzer, Heat Prover or E65-1 as obvious in view of Ross et al and Yant et al, Lamb et al or Cherry under 35 USC 103.

Yant et al, Lamb et al or Cherry each discloses the well-known technique of preheating an incoming gas sample in a winding path prior to a sensor. Such a labyrinth design provides a longer path to permit the gas to come to thermal equilibrium and is obviously desirable for the primary references.

Patentee contends at pages 25, 26 of the brief that since a longer flow path would tend to result in a slower response time, it would not be obvious to use the same for the OC Analyzer,

Heat Prover and E65-1 sensors, which already have "slow" response times.

This contention is not persuasive for two reasons. First, "slow" is relative. Slow as compared to what? Keep in mind that the comparison can only be made with sensors then available, not including the instant sensor. There is no evidence that the primary reference sensors are slow in response time compared to the then available sensors. Second, longer flow path and quick response time are both desirable features. It becomes a question of balancing one against the other in accordance with engineering considerations to maximize the intended purpose and as such is within the skill of the art.

As for claim 4, E65-1 (see

fig. 1) clearly shows a filter. As for sensing the pressure variation in the combustible annalyzer flow path, that is an obviously desirable feature. Pressure variation of course would influence the final reading. To use standard, well-known means to measure that variation and calibrate the final readings accordingly would be obvious to one of ordinary skill in the art.

Claim 7 stands rejected over OC Analyzer, Heat Prover or E65-1 as obvious in view of Ross et al and Thermox under 35 USC 103. Thermox discloses a pressure regulator for an aspirator to be well-known. It would be obvious for Ross et al to adopt such a regulator. Without it, the aspirator function would be non-uniform. The contention that pressure regulators have

no relevance to oxygen sensors but only to combustible sensors and thus Thermox would only be pertinent if it were drawn to a combustible sensor is totally non-persuasive. What difference does it make what the aspirator is used in combination with? The reference shows a pressure regulator for an aspirator and its use in the Ross et al aspirator is obvious.

Claims 8 and 11 stand rejected over OC Analyzer, Heat Prover or E65-1 as obvious in view of Ross et al, Thermox and Yant et al, Lamb et al or Cherry under 35 USC 103. As discussed previously, both the pressure regulator for the aspirator as well as the labyrinth heating path are obviously desirable features for the primary references. Because of a typographic

error, claim 11 was omitted from this rejection in the final rejection. Since claim 11 is of the same scope as claim 8, it is clear that this rejection is indicated and no new issue is being raised.

New claims 6 and 13 stand rejected over OC Analyzer, Heat Prover or E65-1 as obvious in view of Ross et al and Yant et al, Lamb et al or Cherry and claims 1-3, 6 and 7 of Obiaya. The specific heater structure recited in these claims are recited in the designated claims of the Obiaya patent. This is an obvious type double patenting rejection and is proper even though the Obiaya patent has a later patenting date than the instant patenting date. No terminal disclaimer has been filed to overcome this rejection. Applicant's

argument that no reference shows the mesh heater embedded in a solid electrolyte is puzzling, since the Obiaya patent actually claims that structure.

New claims 5 and 12 stand rejected over OC Analyzer, Heat Prover, or E65-1 as obvious in view of Ross et al and Yant et al, Lamb et al or Cherry and Fisher under 103. In the final rejection, because of a typographic error, Ross et al was inadvertently omitted. Since these claims depend upon claims 4 and 3 respectively, both of which were rejected over Ross et al, it is clear that Ross et al was intended as part of the rejection.

Fisher discloses a combustible sensor essentially similar to that recited in these claims. Note that

Fisher shows coating one junction of thermopile with a catalyst and the other with a non-catalyst. The structure of supporting the thermopile on one surface and the heater on the other surface of a substrate is a mere matter of choice in design and is seen to be within the skill of the art.

TTung:mr
703-557-6702
1/10/84

T. Tung
Primary Patent Examiner
Art Unit 112

Approved
Jan. 10, 1985

Dennis E. Talbert, Jr.
Director, Group 110

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE JOSEPH O.OBIAYA )Appeal No. 86-551
)

JUDGMENT

ON APPEAL from the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

in CASE NO(S). Re. 90/000,449

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

ENTERED BY ORDER
OF THE COURT

Dated May 30, 1986 _____
Francis X. Gindhart,
Clerk

ISSUED AS A MANDATE: June 20, 1986

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

| | | |
|---|---|---|
| JOSEPH O. OBIAYA, | ) | |
| | ) | |
| Plaintiff | ) | No. C 82-1889 |
| | ) | |
| v. | ) | MEMORANDUM |
| | ) | OPINION AND |
| THE BABCOCK & WILCOX COMPANY, et al., | ) | ORDER |
| | ) | |
| | ) | |
| Defendants | ) | |

LAMBROS, DISTRICT JUDGE

This action arises out of a claim for patent infringement brought by plaintiff Joseph O. Obiaya against defendants The Babcock & Wilcox Company (Babcock & Wilcox) and The Lubrizol Corporation (Lubrizol).

On December 5, 1978, United States Patent No. 4,128,458 was issued to plaintiff for the invention of a Combustible Element and Oxygen

Concentration Sensor. Plaintiff alleges that Babcock & Wilcox has infringed this patent by manufacturing and selling an oxygen combustible analyzer embodying the patented invention without plaintiff's consent. Plaintiff further alleges that defendant Lubrizol has infringed upon the patent by using an oxygen and combustibles analyzer embodying the patented invention.

Defendants have raised a counterclaim challenging the validity of the patent at issue in this action. On September 26, 1983, Babcock & Wilcox requested a reexamination of the plaintiff's patent by the U.S. Patent and Trademark Office (PTO) pursuant to 35 U.S.C. §302 and 37 C.F.R. § 1.501. The PTO granted Babcock & Wilcox's reexamination request, stating that it

raised substantial new questions concerning the patentability of plaintiff's invention. Defendant Babcock & Wilcox has filed a motion to stay this action pending the outcome of the reexamination proceedings.

35 U.S.C. §302 provides that any party may petition the PTO to review the validity of a patent, subsequent to its issuance, on the basis of new information about preexisting technology ("prior art") that may have escaped review at the time of the initial examination of the patent application. Congress established the reexamination procedure to "permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation." H.R. Rep. No.

96-1307, Part I, 96th Cong., 2nd Sess. 4, reprinted in [1980] U.S. Code Cong. & Ad. News 6460, 6463. This procedure allows for the validity of a patent to be tested in the PTO, which has a greater expertise in this area than do the courts.

A district court may exercise its discretion in deciding whether to stay an action. Ohio Environmental Coun. v. U.S. Dist. Court, Etc., 565 F.2d 393, 396 (6th Cir. 1977). "[T]he power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants." Landis v. North American Company, 299 U.S. 248, 254 (1936). The legislative history of the reexamination

provisions, 35 U.S.C. §301 et seq., indicates that Congress intended the courts to exercise their power to stay court proceedings during the pendency of a patent reexamination.

> The bill does not provide for a stay of court proceedings. It is believed by the committee that stay provisions are unnecessary in that such power already resides with the Court to prevent costly pretrial maneuvering which attempts to circumvent the reexamination procedure. It is anticipated that these measures provide a useful and necessary alternative for challengers and for patent owners to test the validity of United States patents in an efficient and relatively inexpensive manner.

H.R. Rep. No. 96-1307, Part I, 96th Cong., 2nd Sess. 4, reprinted in [1980] U.S. Code Cong. & Ad. News 6460, 6463.

A stay of the present court proceeding pending the patent reexamintion will not unduly delay the

resolution of this action. Reexamination proceedings are to be conducted by the PTO with special dispatch. 35 U.S.C. §305. Moreover, the results of the reexamination can substantially effect the litigation pending in this Court. Were there PTO to determine that the patent is invalid, plaintiff's infringement claims against defendants would become moot. The PTO could also modify the scope of the patent which would alter some of the issues raised in this action. Thus, considerations of judicial economy and efficiency support a stay of this action pending the outcome of the reexamination proceedings.

Plaintiff has opposed the motion to stay, arguing that he should be permitted to proceed with discovery

on a number of issues that he claims are essential to his arguments before the PTO in the reexamination proceedings. The scope of the reexamination proceedings is limited to a review of the "prior art" (consisting of patents or printed publications) which may have a bearing on the patentability of plaintiff's invention. 35 U.S.C. § 301 et seq. Pursuant to 37 C.F.R. §1.510(a)(4), the party requesting a reexamination must certify that a copy of the reexamination request as well as all prior art relied on in the request has been served in its entirety on the patent owner. Consequently, Babcock & Wilcox is obligated to make plaintiff aware of all prior art which they have referred to in challenging the patent. Additionally, plaintiff will have the

opportunity to present his position with respect to this prior art at the reexamination proceedings in the form of affidavits and declarations. 37 C.F.R. §§1.131-32.

Defendant Babcock & Wilcox's motion to stay this action pending the reexamination proceedings is hereby granted. The parties shall notify the court when a conclusive decision has been made by the PTO.

IT IS SO ORDERED.

Thomas D. Lambros
United States District Judge

DATED: 2/17/84

## Certificate of Service

This is to certify that three (3) copies of the foregoing APPENDIX TO PETITION FOR WRIT OF CERTIORARI have been served by U.S. air mail, postage pre-paid, on the Solicitor General, Department of Justice, Washington, D.C., 20530, and that three (3) copies of the foregoing APPENDIX TO PETITION FOR WRIT OF CERTIORARI have been served by U.S. air mail, postage pre-paid, on Thomas C. Tarolli, Esq., Yount & Tarolli, 1111 Leader Building, Cleveland, Ohio 44114, attorney for requester, Babcock & Wilcox Company, this 15th day of September, 1986.

JOSEPH O. OBIAYA